

Appl. No. : 10/053,014
Filed : October 16, 2001

REMARKS

Rejections Under 35 U.S.C. § 103

The Examiner has rejected Claims 26-41 under 35 U.S.C. § 103(a) as unpatentable over Perez, Jr. in view of Smith.

Independent claims 26 and 38 are directed to a *method* of conducting an examination within the vaginal cavity, wherein, *inter alia*, a speculum is provided having a handle and a dilator, wherein the dilator consists of a shorter dilator member and a longer dilator member, and the shorter dilator member is positioned between the longer member and the handle.

In the Office Action, the Examiner acknowledges that Perez lacks the use of a longer member on the bottom and the shorter member on the top. The Examiner asserts, however, that "it would have been obvious to one of ordinary skill in the art at the time that the invention to provide Perez handle flipped with the shorter dilator on top in order to obtain a different view." In doing so, the Examiner provides no support for the proposed modification of the Perez speculum for use in the claimed method. Instead, in making this rejection, the Examiner is merely relying on the disclosure of the present application as a roadmap. In order to avoid such hindsight reconstruction, the M.P.E.P. requires the Examiner, *inter alia*, to set forth in the Office Action "an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification." M.P.E.P. § 706.02(j). Accordingly, Applicants respectfully submit that the §103(a) rejection is improper.

The Examiner also acknowledges that Perez lacks the dilator being disposed at an angle greater than 90 degrees. The Examiner asserts that "Smith teaches the use of the increased angle." Based upon this reading of Smith, the Examiner asserts that "it would have been obvious to one of ordinary skill in the art at the time of the invention to provide Perez with the angle as taught by [sic] in order to get a better view." Smith, however, suffers from the same defect as Perez and lacks the use of a longer member on the bottom and the shorter member on the top. Thus, neither Perez nor Smith provides any motivation to make the combination urged by the Examiner. As noted in the present application, traditional specula do not effectively dilate the vagina when the patient is positioned on a flat surface because the arrangement and positioning of the dilators are inadequate. Furthermore, these traditional specula cannot be tilted or otherwise manipulated due to the particular arrangement of the specula when the patient is

positioned on a flat surface. Accordingly, in light of differences in its intended use, neither Perez nor Smith teach or suggest the modification urged by the Examiner. In particular, neither Perez nor Smith suggests the use of an increased angle where the shorter dilator member is disposed between the longer member and the handle.

In short, Perez and Smith are directed to traditional specula having the same configurations and disadvantages noted by Applicants. Neither Perez nor Smith teach or suggest the arrangement and method as presently claimed. Furthermore, since neither Perez nor Smith teach or suggest the particular problem solved by the arrangement and method as claimed, Perez and Smith teach away from the claimed invention.

It is also noted that the Examiner's rejection does not address features identified in the dependent *method* claims, including positioning of the shorter member adjacent to the cervix and adapted to reposition the vagina to reveal the cervix in the particular method claimed (claim 27), the use of an actuator adapted to rotate at least one dilator member and the actuator is activated to rotate at least one dilator member where the shorter dilator member is disposed between the longer dilator member and the handle in the particular method claimed (claim 28), an actuator further adapted to rotate the shorter dilator member in the particular method claimed (claims 29), an actuator further adapted to rotate the longer dilator member in the particular method claimed (claim 30), rotating the shorter member with respect to the longer member to adjust the angular relation between the members in the particular method claimed (claim 31), rotating the longer member with respect to the shorter member to adjust the angular relation between the members in the particular method claimed (claim 32), rotating the second, longer member proximate to a junction of the second dilator member and the handle in the particular method claimed (claim 33), rotating the first, shorter member proximate to a junction of the first dilator member and the handle in the particular method claimed (claim 34), a coupler adapted to facilitate adjustment of the relative spatial position between the first and second dilator members in the particular method claimed (claim 35), the dilator disposed at an angle between about 100 degrees and 145 degrees with respect to the handle in the particular method claimed (claim 36) and the dilator is disposed at an angle between about 90 degrees and 135 degrees with respect to the handle in the particular method claimed (claim 37). Similarly, the Examiner's rejection does not address the particular *methods* set forth in claims 39-41.

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In light of the foregoing, Applicants respectfully submit that the rejection of claims 26-41 is improper.

CONCLUSION

The applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. In light of this response, reconsideration and withdrawal of the outstanding rejections is respectfully requested.

If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

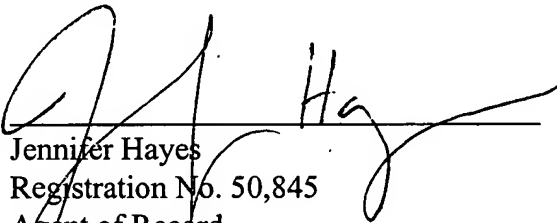
Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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